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10/823,032	04/13/2004	Robert H. Kummer JR.	F-791-O1	3383
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PITNEY BOWES INC.			LIOU, ERIC	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/823,032	Applicant(s) KUMMER ET AL.	
	Examiner Eric Liou	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

1. Claims 1-19 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments filed 10/3/07 have been fully considered but they are not persuasive.
3. Applicant argues, "in Eskandari, there is no disclosure, teaching or suggestion of "deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file" as in the present invention." The Examiner respectfully disagrees. Eskandari teaches a currently enabled operating feature 32 can be selected to be disabled and the independent parameter 470 (operating file) representing the enabled operating feature 32 can be removed from the franking system's parameter set 458 (Eskandari: paragraph 0061). Moreover, Eskandari further teaches saved operating features of the franking system can be updated by removing operating features to be disabled from the saved operating features. Thus, Eskandari teaches deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file.
4. Applicant submits that Eskandari expressly teaches away from deleting operating files. The Examiner notes, teaching away arguments are not applicable under a section 102 rejection. See MPEP Section 2131.05. "Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by

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the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). See also *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir 2003) (The question of whether a reference is analogous art is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Eskandari et al., U.S. Publication No. 2002/0133471.

3. As per claims 1 and 8, Eskandari discloses a method and system for a mailing machine to change operational features comprising: establishing a communication link with a remote data center via a network (Eskandari: Figure 1; paragraph 0066, “remote location via a computer network such as the internet” – The Examiner interprets the system device used to enter the authorization code 14 at the remote location to be a remote data center.); receiving from the remote data center, via the communication link, a directory file, the directory file including an indication of all operational features that should be enabled within the mailing machine (Eskandari: Figure 1, “14”; paragraphs 0019, 0031, 0034, 0042, 0053, 0059-0060, and 0066 – The Examiner interprets the authorization code 14 to be the directory file based on the definition of a “file” in the Microsoft Computer Dictionary. See reference U in the PTO-892 form.), each of the operational features having at least one associated operating file required to implement the operational feature (Eskandari: paragraphs 0017-0018, 0045, and 0047-0048, “parameter set”); determining if an operating file stored in a memory of the mailing machine is not associated with an operational feature indicated in the directory file (Eskandari: Figure 1, “36”; paragraphs 0042 and 0062); and deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file (Eskandari: Figure 1, “36”; paragraphs 0031, 0042, and 0061-0062), wherein deletion of any operating file stored in the memory of the mailing machine that is not associated with an operational feature indicated in the directory file disables an operational feature with which the deleted operating file is associated (Eskandari: Figure 1, “36”; paragraphs 0031, 0042, and 0061-0062).

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4-5, 9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471.

6. As per claims 2 and 9, Eskandari discloses the method and system of claims 1 and 8 as described above. Eskandari further discloses receiving from at least one operating file associated with a new operational feature to be enabled in the mailing machine (Eskandari: paragraphs 0037, 0050 and 0066), the directory file including an indication of the new operational feature (Eskandari: paragraphs 0019, 0031, 0034, 0042, 0053, 0059-0062, and 0066); and storing the at least one operating file associated with the new operational feature in the memory of the mailing machine (Eskandari: paragraph 0062-0063). Eskandari does not disclose receiving from the remote data center at least one operating file. Eskandari discloses receiving information from a remote location (Eskandari: paragraph 0066).

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included receiving from the remote data center at least one operating file as disclosed by Eskandari for the advantage of

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allowing an operator to control the mailing machine without being physically present at the machine.

8. As per claims 4 and 11, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses activating the at least one operating file associated with the new operational feature, thereby enabling the new operational feature in the mailing machine (Eskandari: paragraphs 0042 – The Examiner interprets the step of the franking module enabling and disabling operating features to be the step of activating the at least one operating file associated with the new operational feature.).

9. As per claims 5 and 12, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses updating an activation status stored in the memory of the mailing machine to correspond to the directory file (Eskandari: paragraph 0062 – The Examiner notes, one of basic knowledge would recognize that information saved on a system can readily be stored in a table format in order to better organize the data. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.).

10. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Choksi et al., U.S. Patent No. 6,477,243.

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11. As per claims 3 and 10, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses the receipt of the directory file and the at least one operating file associated with the new operational feature (Eskandari: paragraphs 0037, 0050, and 0066). Eskandari does not disclose sending confirmation of the receipt of information.

12. Choksi discloses sending confirmation of the receipt of information (Choksi: column 2, lines 18-23).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included sending confirmation of the receipt of information as disclosed by Choksi for the advantage of notifying a customer that the information required to perform a particular task has been received.

14. Claims 6, 13, 15-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Montgomery et al., U.S. Publication No. 2003/0101148.

15. As per claims 6 and 13, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses processing the directory file and at least one operating file (Eskandari: paragraphs 0042 and 0062). Eskandari does not disclose signing a file with a digital signature and verifying the signature wherein if the digital signature does not verify, processing of the files are not performed.

16. Montgomery discloses verifying a digital signature and authenticating a postage indicium (processing of files) if the verification is successful (Montgomery: paragraph 0013).

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17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included signing a file with a digital signature and verifying the signature wherein if the digital signature does not verify, processing of the files are not performed as disclosed by Montgomery for the advantage of verifying that the received files are from a trusted party (Eskandari: paragraphs 0012-0013).

18. As per claim 15, Eskandari discloses a mailing machine comprising: a network adapted to communicate with a remote data center via a network (Eskandari: paragraph 0066, “remote location via a computer network”), the mailing machine adapted to receive from the data center a directory file associated with a new operational feature to be enabled in the mailing machine (Eskandari: paragraphs 0031, 0042 0066 – The Examiner interprets the authorization code 14 to be the directory file based on the definition of a “file” in the Microsoft Computer Dictionary. See reference U in the PTO-892 form.), the directory file including an indication of all operational features that should be enabled within the mailing machine (Eskandari: Figure 1, “14”; paragraphs 0019, 0031, 0034, 0042, 0053, 0059-0060, and 0066), each of the operational features having at least one associated operating file required to implement the operational feature (Eskandari: paragraphs 0017-0018, 0045, and 0047-0048, “parameter set”); a memory (Eskandari: paragraphs 0062-0063); a controller coupled to the network and memory (Eskandari: Figure 1, “36”), the controller adapted to determine if an operating file stored in the memory is not associated with an operational feature indicated in the directory file and delete any operating files stored in the memory that are not associated with an operational feature indicated in the directory file (Eskandari: Figure 1, “36”; paragraphs 0031, 0042, and 0061-0062), wherein deletion of any operating file stored in the memory of the mailing machine that is not associated

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with an operational feature indicated in the directory file disables an operational feature with which the deleted operating file is associated (Eskandari: Figure 1, “36”; paragraphs 0031, 0042, and 0061-0062).

19. Eskandari does not disclose a modem and receiving at least one operating file from the data center.

20. Eskandari discloses receiving information from the data center (Eskandari: paragraph 0066).

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Eskandari to have included receiving at least one operating file from the data center as disclosed by Eskandari for the advantage of allowing an operator to control the mailing machine without being physically present at the machine.

22. Montgomery discloses a modem (Montgomery: paragraph 0089)

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included a modem as disclosed by Montgomery for the advantage communicating information through a network.

24. As per claim 16, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses the controller is further adapted to store the at least one operating file associated with the new operational feature in the memory and activate the at least one operating file associated with the new operational feature, thereby enabling the new operational feature in the mailing machine (Eskandari: paragraphs 0042 and 0062-0063 – The Examiner interprets the step of the franking module enabling and disabling

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operating features to be the step of activating the at least one operating file associated with the new operational feature.).

25. As per claim 18, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses an activation status stored in the memory, wherein the controller is further adapted to update the activation status to correspond to the directory file. (Eskandari: paragraph 0062 – The Examiner notes, one of basic knowledge would recognize that information saved on a system can readily be stored in a table format in order to better organize the data. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.).

26. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Shaw et al., U.S. Publication No. 2002/0176111.

27. As per claims 7 and 14, Eskandari discloses the method and system of claims 1 and 8 as described above. Eskandari further discloses wherein operational features include accounting features, postal service features, type and capacity of external scales that can be utilized with the mailing machine, and data capture features (Eskandari: paragraphs 0040, 0043-0045, and 0047-0048). Eskandari does not disclose printing ad slogans and printing inscriptions.

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28. Shaw discloses printing ad slogans and printing inscriptions (Shaw: Figure 2, "214"; paragraphs 0003 and 0005).

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included printing ad slogans and printing inscriptions as disclosed by Shaw for the advantage of creating a mailpiece envelope that has more information.

30. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Montgomery et al., U.S. Publication No. 2003/0101148 and further in view of Choksi et al., U.S. Patent No. 6,477,243.

31. As per claim 17, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses the receipt of the directory file and the at least one operating file associated with the new operational feature (Eskandari: paragraphs 0037, 0050, and 0066). Eskandari in view of Montgomery does not disclose wherein the controller is further adapted to send confirmation of the receipt of information utilizing a modem.

32. Choksi discloses sending confirmation of the receipt of a message (Choksi: Abstract and column 2, lines 18-23 – The Examiner notes, sending a confirmation message via e-mail suggests utilizing a modem.).

33. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Eskandari in view of Montgomery to have included wherein the controller is further adapted to send confirmation of the receipt of information

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utilizing a modem as disclosed by Choksi for the advantage of notifying a customer that the information required to perform a particular task has been received.

34. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Montgomery et al., U.S. Publication No. 2003/0101148 and further in view of Shaw et al., U.S. Publication No. 2002/0176111.

35. As per claim 19, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses wherein operational features include accounting features, postal service features, type and capacity of external scales that can be utilized with the mailing machine, and data capture features (Eskandari: paragraphs 0040, 0043-0045, and 0047-0048). Eskandari does not disclose printing ad slogans and printing inscriptions.

36. Shaw discloses printing ad slogans and printing inscriptions (Shaw: Figure 2, "214"; paragraphs 0003 and 0005).

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Eskandari in view of Montgomery to have included printing ad slogans and printing inscriptions as disclosed by Shaw for the advantage of creating a mailpiece envelope that has more information.

Conclusion

38. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

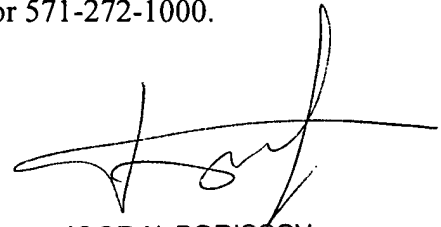
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PRIMARY EXAMINER